

MINISTRY OF LAW AND HUMAN RIGHTS REPUBLIC OF INDONESIA
DIRECTORATE GENERAL OF INTELLECTUAL PROPERTY RIGHTS

Jalan Daan Mogot km. 24, Tangerang 15119 - Indonesia
Telephone: +62 21 5517921 Facsimile: +62 21 5517921
Homepage: www.dgip.go.id E-mail: docoop@dgip.go.id

January 13, 2010

Reference No. : ~~DKI~~ 5-HM.02.04-27.21

Mr. Francis Gurry
Director General
World Intellectual Property Organization
34, chemin des Colombettes,
1211 Geneva 20
SWITZERLAND

Reçu par *[Signature]*

14 JAN. 2010

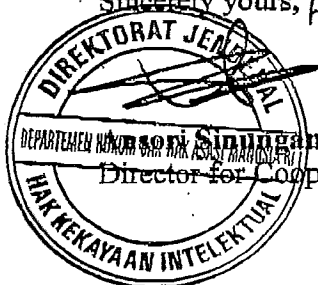
Received by WIPO

Dear Mr. Gurry,

On behalf of the Director General of IPR, I am pleased to send you herewith our responses related to the survey on the Lisbon System for the Protection of Appellations of Origin and their International Registration.

Thank you very much for your attention and continuing support.

Sincerely yours, *[Signature]*



- CC:
1. Director General of IPR
 2. Directors, DGIPR

Réponse à signer
par M
Réponse à préparer
par M

Autre action par
M *[Signature]*
M *Rajal Diaz, N.*

Copie pr information
M *[Signature]*
M *[Signature]*

Annex I, page 11.

Questions to be Addressed in Response to the Survey on the Lisbon SystemThe Basis for Protection in the Country of Origin

Some have interpreted the phrase "recognized and protected as such" in Article 1(2) of the Lisbon Agreement as restricting eligibility for registration and protection under the Agreement to appellations of origin recognized and protected under *sui generis* legislation in the country of origin. Others take the view that this phrase does not impose a means by which an appellation of origin should be protected in the country of origin, nor the specific legal form of protection, as long as the geographical denomination in question meets the definition provisions of Article 2 of the Agreement. Rule 5(2)(a)(vi) of the Regulations under the Lisbon Agreement broadly refers to protection in the country of origin by virtue of legislative provisions, administrative provisions, judicial decisions or registration.

Question 1:

Should the basis for protection in the country of origin in Article 1(2) of the Agreement and Rule 5(2)(a)(vi) of the Regulations be revised, in view of the different means of protection existing around the world for geographical indications?

Answer 1:

Yes, Article 1(2) of the Lisbon Agreement and Rule 5(2)(a)(vi) of the Regulations should be revised by adds a phrase: "which is stipulated by *sui generis*, legislative provision, administrative provision, judicial decision, or registration system" after word "origin" of Article 1(2) of the Lisbon Agreement, and finally become:

Article 1

(2) They undertake to protect on their territories, in accordance with the terms of this Agreement, the appellations of origin of products of the other countries of the Special Union, recognized and protected as such in the country of origin which is stipulated by *sui generis*, legislative provision, administrative provision, judicial decision, or registration system and registered at the International Bureau of Intellectual Property (hereinafter designated as "the

Annex I, page 2:

International Bureau" or "the Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization").

Terminology and Definitions

A number of domestic laws exist under which protection is available for appellations of origin on the basis of a definition that corresponds to the definition provisions of Article 2 of the Lisbon Agreement. Other domestic laws provide protection for geographical indications on the basis of the definition provisions of Article 22.1 of the TRIPS Agreement. Domestic legislation also exists with both a definition for appellations of origin and a definition for geographical indications or variations of those terms. Moreover, there are also domestic laws dealing with the same subject matter without defining the term "appellation of origin" or the term "geographical indication".

Question 2:

Should the definition provisions of Article 2 of the Lisbon Agreement be amended?

Answer 2 :

Yes, Article 2 of the Lisbon Agreement should be amended as below:

Article 2 (1):

By adds a phrase: "and geographical indications are" after word "**origin**" of Article 2(1) of the Lisbon Agreement, and finally become:

(1) In this Agreement, appellation of origin "**and geographical indications are**" means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.

Article 2(2)

By adds a phrase: "and geographical indications" after word "**origin**" of Article 2(2) of the Lisbon Agreement, and finally become:

Annex I, page 3i

(2) The country of origin is the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin "and geographical indications" which has given the product its reputation.

Scope of Protection

The Lisbon Agreement does not define the terms "usurpation" and "imitation", as contained in its Article 3, but the negotiating history would appear to indicate that these terms are aimed to prevent use of an internationally registered appellation of origin on a product of the same kind not originating from the area to which the appellation of origin refers or a product of the same kind that, while originating in that area, does not meet the quality or characteristics on which protection for the appellation of origin is based.

Question 3:

Should Article 3 of the Lisbon Agreement be amended so as to address the protection of appellations of origin against use on products that are not of the same kind and, if so, on the basis of what criteria?

Answer 3 :

Yes, Article 3 of the Lisbon Agreement should be amended by define what kind of usurpation of actions.

Amendment Article 3 of the Lisbon Agreement on the basis of criteria:

- mislead the consumer;
- market monopoly;
- manipulated trading; and
- unfair competition.

Question 4:

What amendments would be necessary to Article 3 in connection with the answer to questions 1 and 2 above ?

Annex I, page 4:

Answer 4:

Amendments to Article 3 would be necessary in connection with the questions 1 and 2 above by adds a phrase: **“consisting of: bad faith action, unfair competition action, ..., and so on”** after words usurpation and adds a phrase: **“products of appellation of origin and geographical indications”** after words imitation, and finally become:

Article 3:

Protection shall be ensured against any usurpation **“consisting of: bad faith action, unfair competition action, ..., and so on”** or imitation **“products of appellation of origin and geographical indications”**, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or the like.

Effects of Registration

The negotiating history of the Lisbon Agreement shows that the Lisbon system is meant to:

(a) require a country of origin to provide information in international applications allowing the other member countries proper examination as to whether they can protect the internationally registered appellations of origin concerned;

(b) require these other countries to take position within a period of one year from receipt of the notification of an international registration and, in case they submit a declaration of refusal, to specify the grounds for such refusal; and

(c) shield such an appellation of origin against becoming a generic denomination.

Question 5:

As regards point (a) above,are there elements in the application and registration procedures requiring improvement and, if so, which are these elements?

Annex I, page 51 :

Answer 5 :

Yes, there are elements in the application and registration procedures requiring improvement namely:

- how the country of origin to provide data base of products of appellation of origin and geographical indications which is registered and protection are;
- how the contracting country accepted of data base of products of appellation of origin and geographical indications which is registered and protection are;
- how the contracting country knows of appellation of origin and geographical indications laws which is registered and protection are.

Accordingly, the country of origin could provide information in international applications therefore allowing the other member countries proper examination as to whether they can protect the internationally registered appellations of origin.

Question 6:

As regards point (b) above, are there elements in the procedures for the notification of refusals, withdrawals of refusals and statements of grant of protection requiring improvement and, if so, which are these elements?

Answer 6 :

Yes, there are element in the procedures for the requiring improvement namely:

- how the mechanism and time lines for the contracting country to make notification of refusals, withdrawals of refusals and statements of grant of protection;
- time period for one year of the notification should be provide for extension time.

Question 7:

As regards point (c) above, would there be a need to amend Article 6 of the Lisbon Agreement, in order to allow for certain exceptions , or does the phrase "cannot, in that country, be *deemed* to have become generic" provide sufficient leeway in that respect?

Annex I, page 6:

Answer 7 :

Yes, there is a need to amend Article 6 of the Lisbon Agreement with regards:

- to allow a certain exceptions for third party which has been used in that country from a date prior to such notification beside the competent Office of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use, third party also have right to become user the appellation of origins or geographical indications by virtue of the national law.
- the word "cannot" on the phrase "cannot, in that country, be *deemed* to have become generic" could be remove and then replace with "shall not" or "must not", and finally become:

Article 6:

An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5, in that country, "**shall not**" be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

Question 8:

Are there elements in the procedures of Rule 16 of the Regulations under the Lisbon Agreement concerning the notification by a member country of an invalidation of the effects of an international registration and its recording in the International Register requiring amendment and, if so, which are these elements ?

Answer 8 :

Yes, there are several elements of Rule 16 of the Regulations should amendment namely:

1. a phrase: "no longer" of Rule 16 of the Regulations should be remove.

Annex I, page 71

2. a phrase: "the competent authority of that contracting country" should be define clearly conciseness..

Prior UsersQuestion 9:

Would there be a need to amend Article 5(6) of the Lisbon Agreement , or does the fact that Article 5(6) of the Lisbon Agreement and Rule 12 of the Regulations under the Agreement only apply in case a member country does not notify a declaration of refusal provide sufficient leeway in this respect?

Answer 9 :

Yes, Article 5(6) of the Lisbon Agreement should be a need to amend, by adds a phrase: "or have right to become as user of appellation of origins or geographical indications with filing that right to the office of contracting country by virtue of the national law" after words "use", and finally become;

Article 5

{International Registration; Refusal and Opposition to Refusal; Notifications; Use Tolerated for a Fixed Period}

(6) If an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Office of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use and "third parties have right to become as user of appellation of origins or geographical indications with filing that right to the office of contracting country by virtue of the national law", on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3), above .

Annex I, page 8

Other IssuesQuestion 10:

What other issues concerning law or practice directly or indirectly related to the functioning of the Lisbon system do you consider require amendment or modification of the existing Lisbon Agreement and would you like to bring to the attention of the Working Group on the Development of the Lisbon System?

Answer 10 :

Yes, there are other issues concerning law or practice of the Lisbon system should be consider require amendment or modification and i would like the attention of the Working Group on the Development of the Lisbon System, namely:

A. Lisbon Agreement

1. Article 1 (2) should be revise, so the meaning more clearly and conciseness.
2. Article 2: definition of appellation of origin and geographical indications should be redefine and harmonize, so the meaning more clearly and conciseness.
3. Article 3 should be revise, so the meaning more clearly and conciseness.
4. Article 4 should be revise and redefine, so the meaning more clearly and conciseness
5. Article 5 should be revise and redefine, so the meaning more clearly and conciseness, for example a word of "private" should be remove, because possesses of rights is communal.
6. Article 6, should be revise and redefine, so the meaning more clearly and conciseness.